

**REMARKS**

Claims 1 - 5 are pending in the application and stand rejected. Claims 1 - 5 are amended herein. No new matter has been added by these amendments.

In the Office Action the Examiner rejected claims 1 - 5 under 35 U.S.C. § 112, second paragraph. In addition, the Examiner rejected claims 1 - 2 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over *Matsushima*, and rejected claims 3 - 5 under 35 U.S.C. § 103(a) as obvious over *Matsushima*.

Regarding the rejection under 35 U.S.C. § 112, second paragraph, the Examiner argued that claim 1 was indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 has been amended to more clearly recite the subject matter of the invention. For example, the limitation "said core string has a high thermal contraction coefficient" has been canceled. The claim as amended recites the structural relationships of the components, as well as the relative relationships of the physical properties. Accordingly, Applicant respectfully asserts that this rejection has been overcome and that no new matter has been added by these amendments.

Claim 1 has been amended to clearly recite that the core string is "woven in said element-mounting edge portion." Applicant asserts that this limitation was present in the claim as-filed, i.e., "an element-mounting edge portion, in which a core string is woven," and, therefore, this amendment neither adds new matter nor narrows the claim. Regarding the rejections under 35 U.S.C. §§ 102(e) and 103(c), *Matsushima* fails to at least disclose "an element-mounting edge portion, in which a core string is woven." Specifically, in *Matsushima*, the core string 9, which the Examiner identifies as

corresponding to the recited core string, "is inserted through the coil-shaped fastener elements 14 so as to form a coil-shaped element row 15." (Col. 3, line 64 - col. 4, line 1.) This fastener element row is "placed on the fastener-element-mounting portion 11 formed at the side edge portion 5 of the fastener tape 1" and then "the core string 9 is pierced through the fastener element row 15, which is sewed onto the fastener tape with multi-thread chain stitch by a sewing machine." (Col. 4, lines 1 - 9.) In short, the core string is inserted through the coiled fastener element row and then sewn onto the slide fastener tape. As such, the core string is not woven into the element-mounting edge portion, as required by claim 1. Moreover, it would not be obvious to do so, as to weave the core string, which is inside the coiled fastener element row, into the element-mounting edge portion would destroy the utility of the fastener elements.

Moreover, the Examiner continues to argue that the recited structure having differing thermal contraction coefficients is inherently disclosed in *Matsushima*. As argued in the previous response, the Federal Circuit has held that inherent anticipation arises when "the prior art necessarily functions in accordance with, or includes, the claimed limitation." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999). The standard for determining inherency is as follows:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

*Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 (Fed. Cir. 1991). Moreover, to support an anticipation rejection based on inherency, an examiner must provide factual and technical grounds establishing that the inherent feature

*necessarily* flows from the teachings of the prior art. See *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990). There is no disclosure in *Matsushima* either teaching or suggesting a warp disposed between the core string and the tape main portion, where the warp has a thermal contraction coefficient higher than the foundation warp used for the tape main portion and lower than the core string, as recited in amended claim 1. In this case, the Examiner is attempting to establish inherency by relying on probabilities and possibilities, which is not appropriate according to well-established Federal Circuit case law.

The Examiner relies on *In re Fitzgerald* for the proposition that the Applicant must prove that *Matsushima* does not teach the recited slide fastener tape. The Examiner's reliance on this case is misplaced. In *Fitzgerald*, the question revolved around whether a product having certain functional properties would necessarily result from the process taught in the prior art; specifically, whether a process disclosed in the prior art would result in "said polymer in said patch having a reduced degree of crystallization shrinkage of about 25% or less of its maximum crystallization shrinkage." That is not the case here. Amended claim 1 does not recite functional limitations. Instead, amended claim 1 recites a slide fastener tape comprised of elements having varying physical properties. Specifically, amended claim 1 recites a warp disposed between the core string and the tape main portion, where the warp has a thermal contraction coefficient higher than the foundation warp used for the tape main portion and lower than the core string. Moreover, in the Board decision affirmed by the Court in *Fitzgerald*, the Board noted that the objects of the subject invention and the prior art were commensurate in scope. Here, on the other hand, the objects of the invention in

*Matsushima* were to provide a woven fastener stringer that is woven of transparent or semi-transparent synthetic fiber monofilament yarn. An object of the current invention is to prevent puckering in the element-mounting edge portion of the slide fastener tape when the tape is subject to various thermal conditions. This object is neither disclosed nor suggested in *Matsushima*.

Thus, for at least the above reasons, claim 1, as well as claims 2 - 5 that depend therefrom, are allowable over the cited art.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1 - 5 in condition for allowance. Applicant submits that the proposed amendments of claims 1 - 5 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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By: 

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